

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:	§	Filed: March 18, 2004
Dettinger et al.	§	
	§	Group Art Unit: 2162
Serial No.: 10/803,603	§	
	§	Examiner: Giovanna B. Colan
Confirmation No.: 5874	§	

For: A METHOD FOR PROVIDING WORKFLOW FUNCTIONALITY AND
TRACKING IN AN ANNOTATION SUBSYSTEM

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office to fax number 571-273-8300 to the attention of Examiner Giovanna B. Colan, or electronically transmitted via EFS-Web, on the date shown below:

August 1, 2008	/Mayra Bravo/
Date	Mayra Bravo

REPLY BRIEF

Dear Sir:

Applicants submit this Reply Brief to the Board of Patent Appeals and Interferences in response to Examiner's Answer mailed on June 3, 2008. While Applicants' maintain each of the arguments submitted in Applicants' previously submitted Appeal Brief, Applicants make the following further arguments in light of the Examiner's Answer.

ARGUMENTS

1. The Combination of *Bays* in view of *Setya* does not Render Claims 1, 4-21 and 24-31 Obvious.

The Applicable Standard

The Examiner bears the initial burden of establishing a prima facie case of obviousness. See MPEP § 2141. Establishing a prima facie case of obviousness begins with first resolving the factual inquiries of *Graham v. John Deere Co.* 383 U.S. 1 (1966). The factual inquiries are as follows:

- (A) determining the scope and content of the prior art;
- (B) ascertaining the differences between the claimed invention and the prior art;
- (C) resolving the level of ordinary skill in the art; and
- (D) considering any objective indicia of nonobviousness.

Once the *Graham* factual inquiries are resolved, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art.

The Examiner's Arguments

On pages 16-17 of the *Examiner's Answer*, the Examiner provides a rebuttal with respect to the *Applicants' Appeal Brief*, and further elaborates on previously submitted arguments, suggesting that Applicants' arguments are not persuasive. In response, Applicants respectfully maintain that each of the arguments presented in *Applicants' Appeal Brief* are correct, and further provide the following arguments in response to the Examiner's Answer.

Applicants' Response to Examiner's Arguments

Claims 1, 13, 18, 21, 26

Respectfully, Applicants submit that the Examiner has not properly characterized the teachings of the references and/or the claims at issue. Accordingly, a prima facie case of obviousness has not been established.

For example, regarding claim 1, *Bays* does not disclose a method for tracking the status of an annotation, comprising applying a set of state rules to determine a first state of the annotation based on annotation data. Claims 13, 18, 21 and 26 recite similar claim limitations.

On page 16-17 of the *Examiner's Answer*, the Examiner reiterates that *Bays* discloses this element at col. 3, lines 25-30, and further cites to additional portions of *Bays* such as col. 4, lines 1-7, 14-16 and 17-24. As stated in the *Applicants' Appeal Brief*, Col. 3, lines 25-30 simply discloses a way to define what annotation data to present to a particular user (*i.e.*, filtering), and how to present that annotation data (*i.e.* transforming). The other portions cited by the Examiner simply disclose a method to retrieve the data and the annotations associated with the data. For example, col. 4, lines 1-7 discloses a query mode that allows a user to search for annotations based on a context of data. For example, a "reader first identifies a data material of interest, and further asks for the accompanying annotations with particular characteristics (e.g. where the author field contains Smith)." See *Bays*, col. 4, lines 5-7.

Col. 4, lines 17-24 simply provides further detail regarding the query mode. For example,

"[T]he reader [may wish] to review only certain annotations that relate to the data (e.g. all those by expert X) or when the reader wishes to focus on particular database material and annotation content (e.g. find all the data and annotations about drug molecules have biological activity greater than x (data content) and for which the experts said the experimental measurement was reliable (annotation content)." See *Bays*, col. 4, lines 17-24.

Thus, the cited portions of *Bays* simply disclose a method for a user to filter and transform annotation content by appropriately querying a database containing data and the associated annotation content. Applicants submit that this method of *Bays* simply does not disclose the present claims. Specifically, the cited portions of *Bays* has nothing to do with ‘applying a set of state rules to determine a first state of the annotation based on annotation data’ as recited in the present claims. Yet, the Examiner insists otherwise and argues that the *Application* provides support for this assertion. For example, on page 17 of the *Examiner’s Answer*, the Examiner cites to a portion of paragraph [0023] which states “state rules may define different states of the annotation, for example, based on what fields are (or are not) filled in and, possibly, the actual content of those fields.” See *Application*, para. [0023]. However, the Examiner fails to elaborate further as to how this definition for a ‘state rule’ applies to the cited portion of *Bays*. Is the Examiner suggesting that a ‘state rule’ is the same as a query, and that a ‘state of an annotation’ represents a filtered or transformed version of the annotation? While Applicants appreciate the Examiner’s attempt to read the claims broadly, Applicants submit that the Examiner has broadened the claims well past the bounds of the *Application* as read by a person having ordinary skill in the art. Accordingly, *Bays* does not disclose ‘applying a set of state rules to determine a first state of the annotation based on annotation data’ as disclosed in the present claims.

Therefore, Applicants respectfully request the rejection to claims 1, 13, 18, 21, 26 and the claims that depend therefrom be reversed and the claims be allowed.

CONCLUSION

The Examiner errs in finding that claims 1, 4-21 and 34-31 are unpatentable over *Bays* in view of *Setya* under 35 U.S.C. § 103(a).

Withdrawal of the rejection and allowance of all claims is respectfully requested.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

/Gero G. McClellan, Reg. No. 44,227/

Gero G. McClellan
Registration No. 44,227
Patterson & Sheridan, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Appellant(s)